REMARKS/ARGUMENTS

The Examiner has requested a new title for the invention.

The Examiner has requested that trademarks be designated.

The Examiner has requested that embedded hyperlinks and/or other form of browser-executable code be removed.

The Examiner has objected to claim 6 of this application.

The Examiner has rejected claims 1-21 of this Application under 35 U.S.C. § 101 as being directed to a non-statutory subject matter.

The Examiner has rejected claim 6 of this Application under 35 U.S.C. § 112, second paragraph.

The Examiner has rejected claims 1-21 of this Application under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,219,328 to Schloegel et al. (herein "Schloegel").

Claims 1-21 are pending in this application.

The claims have been amended as set forth above.

All amendments are fully supported by the specification and no new matter has been added.

Reconsideration and allowance in view of the amendments and remarks is respectfully requested.

Title of the Invention

37 C.F.R. 1.72 states:

§ 1.72 Title and abstract.
(a)The title of the invention may not exceed 500 characters in length
and must be as short and specific as possible.

(Emphasis Added).

Furthermore, MPEP 606 states:

"The title should be brief but technically accurate and descriptive..."

The Examiner has requested that the title of the invention be changed. The title of the invention has been amended to "Using Incremental Generation to Develop Software Applications".

Trademarks

MPEP 608.01(v) states:

"Although the use of trademarks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected. Trademarks should be identified by capitalizing each letter of the mark (in the case of word or letter marks) or otherwise indicating the description of the mark (in the case of marks in the form of a symbol or device or other contextual form)"

The Examiner has requested that the use of trademarks be properly designated. The specification has been amended to properly designate trademarks. No new matter has been added.

Hyperlinks in the Specification

MPEP 608.01 states:

"Examiners must review patent applications to make certain that hyperlinks and other forms of browser-executable code, especially commercial site URLs, are not included in a patent application. >37 CFR 1.57(d) states that an incorporation by reference by hyperlink or other form of browser executable code is not permitted.<"

The Examiner has requested that the embedded hyperlink in the specification be removed. The specification has been amended with the deletion of the hyperlink. No new matter has been added.

Objection of claim 6

The Examiner has objected to the use of abbreviation MDO. Claim 6 has been amended to overcome this rejection. Applicants respectfully submit that the objection has been overcome.

<u>Rejection under 35 U.S.C. § 101</u>

The first issue in this case is whether claims 1-21 are directed towards non-statutory subject matter. The Examiner has stated as follows:

> 'Claims 1-21 disclosed by the applicant as being a "computer program product...".'

(Office Action, p. 3).

Claim 1 has been amended in order to overcome the rejection under 35 U.S.C. § 101 as noted above. Amended claim 1 recites:

> A computer program product tangibly embodied in a <u>machine-readable storage device</u>, for using incremental generation to develop applications, the computer program product being operable to cause data processing apparatus to:
> identify a first main development object;
> identify main development objects related to the first main development objects by an aggregation relationship;
> identify main development objects related to the first main development object by an association relationship;
> determine if any identified main development objects have changed; and
> re-generate the first main development object if any identified main development objects have changed.
> (Amended Claim 1)(Emphasis Added).

Claim 1 subject matter is now directed at a machine-readable storage device, which is statutory subject matter. Claims 2-12 depend on claim 1 so therefore they also overcome the rejection.

Claims 13 through 17 do not recite a "computer program." Rather, claim 13 is a system claim for incremental generation and claim 17 is a method claim. Both of these claims recite statutory subject matter. Since claims 13 and 17 do not recite a "computer program...," Applicants respectfully submit that the rejection 35 U.S.C. § 101 for claims 13 and 17 should be withdrawn. Furthermore since claims 14-16 and 18-21 depend on claims 13 and 17, respectively, the rejection 35 U.S.C. § 101 for dependent claims 14-16 and 18-21 should also be withdrawn.

Applicants respectfully submit that the rejection under 35 U.S.C. § 101 has been overcome.

<div align="center">Rejection under 35 U.S.C. § 112</div>

The second issue in this case is whether claim 6 meets the requirements of 35 U.S.C. § 112. The Examiner has stated as follows:

> "The following is a quotation of the second paragraph of 35 U.S.C. § 112:
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
>
> Claim 6 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention."

(Office Action, p. 4).

Applicants respectfully submit that all pending claims in this Application satisfy the requirements of 35 U.S.C. § 112, second paragraph.

The central inquiry with regard to the second paragraph of 35 U.S.C. § 112 is whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. *See, e.g., Personalized Media Communications, Inc. v. Int'l Trade Comm'n,* 161 F.3d 696, 705 (Fed. Cir. 1998); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.,* 806 F.2d 1565, 1576 (Fed. Cir. 1986); *see also Exxon Res. & Eng'g Corp. v. United States,* 265 F.3d 1371, 1375 (Fed. Cir. 2001) ("If one skilled in the art would understand the bounds of the claims when read in light of the specification, then the claim satisfies section 112 paragraph 2."). The Federal Circuit has "not insisted that claims be plain on their face in order to avoid condemnation for indefiniteness"; rather, it has asked only that claims be "amenable to construction, however difficult that task may be." *Exxon,* 265 F.3d at 1375. Only if a claim is "insolubly ambiguous, and no narrowing construction can properly be adopted," may a court hold a claim indefinite. *Id.* As the Federal Circuit has stated, "[i]f the meaning of the claim is discernible, even though the

task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds."

Examiner has not stated the reasons why claim 6 is indefinite. Applicants however have amended claim 6 to more clearly define what MDO is. Applicants respectfully submit that claim 6 is not indefinite under 35 U.S.C. § 112.

Rejection under 35 U.S.C. § 102(e) based on Schloegel

The third issue in this case is whether or not Schloegel anticipates claims 1-21 under 35 U.S.C. § 102(e). Because Section 102 requires "*identity*" as set forth below, and because such identity is <u>not</u> found in the prior art, the Examiners rejection must be withdrawn.

A. Applicable Law:

"A claim is anticipated under 35 U.S.C. § 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987), MPEP 2131.01. The Federal Circuit has repeatedly emphasized that anticipation is established only if (1) all the elements of an invention, as stated in the patent claim, (2) are <u>identically</u> set forth, (3) in a single prior art reference. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) ("To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either expressly or inherently."); *In re Paulsen*, 30 F.3d 1475,1478-79 (Fed. Cir. 1994) ("A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference."); *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997) ("Under 35 U.S.C. 102(b), every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim").

Importantly, the presence of each claim limitation in the disclosure of a reference must be <u>clear</u>. For example, as stated in *Datascope Corp. v. SMEC, Inc.*, "Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture." *Datascope Corp. v. SMEC, Inc.*, 776 F.2d 320 (Fed. Cir. 1985). This concept has been reiterated by the Board of Patent Appeals. For example, in *Ex parte Standish*, the Board stated, "anticipation of a

claimed product cannot be predicated on mere conjecture as to the characteristics of a prior art product." *Ex parte Standish*, 10 USPQ2d 1454, 1457 (Bd. Pat. App. & Int'f 1989).

B. Application of the Law and Reference to the Claims At-Issue:

Applicants respectfully point out that Schoelgel does not anticipate claims 1-21 under 35 U.S.C. § 102(e) because it is not identical to the claims of this Application. Applicants note that Schoelgel is an application for model based code generation, which is different than claims to an application for incremental regeneration of software applications depending on development object changes. All claims are allowable because Schoelgel does not clearly and identically disclose each and every element recited in these claims either expressly or inherently.

Claim 1 recites "a computer program product tangibly embodied in a machine-readable storage device" including the following limitations:

"identify a first main development object;
identify main development objects related to the first main development objects by an aggregation relationship;
identify main development objects related to the first main development object by an association relationship;
determine if any identified main development objects have changed; and
re-generate the first main development object if any identified main development objects have changed."

(Amended Claim 1)(Emphasis Added).

Among other things, claim 1 describes a product for re-generating main development objects when changes have occurred in related development objects. One element of the product includes determining whether any identified main development objects have changed. Schoelgel does not anticipate claim 1, *inter alia*, because Schoelgel does not teach these limitations. Rather, Schoelgel discloses changing the precedence of code generator routines depending on the design. (See Schoelgel, col. 8, ll. 4-7).

Another element of the product includes re-generating the first main development object if any identified main development objects have changed, thereby only regenerating development objects when necessary. Again, Schoelgel does not anticipate claim 1, *inter alia*, because Schoelgel does not teach these limitations. Rather, Schoelgel discloses the creation of

Thread instances and the precedence of specialized code generator routines over base code generator routines. (See Schoelgel, col. 9, ll. 4-18). There is no mention of re-generation based on changes in identified "main development objects."

These are substantial differences than the elements disclosed in claim 1. While Schoelgel discloses changing the precedence of routines based on the design, Applicants disclose re-generating main development objects based on changes in related development objects. Applicants respectfully point out that these are two independent concepts. Because Schoelgel does not disclose the same invention as set forth in claim 1, Schoelgel cannot anticipate claim 1 under 35 U.S.C. § 102(e).

Claims 2-12 are dependent claims that include all the limitations of claim 1 and include additional limitations. Therefore, these claims are allowable for at least the same reasons and further because Schoelgel does not disclose the additional limitations of these dependent claims.

Claim 17 recites "a method for using incremental generation to develop applications" including the following limitations:

> "identifying a first main development object;
> identifying main development objects related to the first main development objects by an aggregation relationship;
> identifying main development objects related to the first main development object by an association relationship;
> <u>determining if any identified main development objects have changed;</u> and
> <u>re-generating the first main development object if any identified main development objects have changed.</u>"

(Amended Claim 17)(Emphasis Added).

Because claim 17 recites the same limitations as claim 1, claim 17 is allowable for at least the same reasons as stated above for claim 1.

Claims 18-21 are dependent claims that include all the limitations of claim 17 and include additional limitations. Therefore, these claims are allowable for at least the same reasons and further because Schoelgel does not disclose the additional limitations of these dependent claims.

Claim 13 recites "system for incremental generation to develop applications" including the following limitations:

"a generator comprising;
a search module configured to identify a first main development object, to identify main development objects related to the first main development objects by an aggregation relationship, and to identify main development objects related to the first main development object by an association relationship;
a comparator module configured to determine if any identified main development objects have changed; and
a generation module configured to re-generate the first main development object if any identified development objects have changed.

(Amended Claim 13)(Emphasis Added).

Among other things, claim 13 describes a system for re-generating main development objects when changes have occurred in related development objects. One element of the product includes re-generating the first main development object if any identified main development objects have changed, thereby only regenerating development objects when necessary. Schoelgel does not anticipate claim 13, *inter alia*, because Schoelgel does not teach these limitations. Rather, Schoelgel discloses attaching base code generator routines to graphical meta modeling entities. (See Schoelgel, col. 8, ll. 27-47). This is substantially different than the elements disclosed in claim 13. Because Schoelgel does not disclose the same invention as set forth in claim 13, Schoelgel cannot anticipate claim 13 under 35 U.S.C. § 102(e).

Claims 14-16 are dependent claims that include all the limitations of claim 13 and include additional limitations. Therefore, these claims are allowable for at least the same reasons and further because Schoelgel does not disclose the additional limitations of these dependent claims.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-244-6319.

Respectfully submitted,

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